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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
011816-0025-999

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Signature _____

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Application Number
10/821,959

Filed
April 12, 2004

First Named Inventor
Geuppert

Art Unit
3729

Examiner
Paul D. Kim

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number _____ 59,512 _____

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attorney or agent acting under 37 CFR 1.34.

January 16, 2008

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Bernhard GEUPPERT	Confirmation No.:	2358
Serial No.:	10/821,959	Art Unit:	3729
Filed:	April 12, 2004	Examiner:	Paul D. Kim
For:	METHOD OF MANUFACTURING AN OPTICAL COMPONENT	Attorney Docket No.:	011816-0025-999

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Claims 9-16, 20, 23, 26, 28-30, 32-36, 38, and 39 stand finally rejected, and claims 27, 31, and 37 have been considered withdrawn. Claims 9-15, 20, 23, 28, 29, 34-36, 38, and 39 have been rejected as allegedly anticipated under 35 U.S.C. § 102(e) by European Patent No. EP1338911A2 to Oshino (“Oshino”). Claims 9, 10, and 13 have been rejected as allegedly anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,581,347 to Le Saux *et al.* (“Le Saux”). Finally, claim 16 has been rejected as allegedly obvious over Oshino or Le Saux in view of U.S. Patent No. 6,515,750 to Malyak *et al.* (“Malyak”). Claims 27, 31, and 37 have been considered withdrawn as directed to a non-elected species. These rejections are improper and are based upon clear errors of fact and law. Accordingly, the rejections should be reconsidered and withdrawn.

I. Oshino fails to disclose all the elements of claims 9-15, 20, 23, 28, 29, 34-36, 38, and 39.

Claim 9 recites a method of manufacturing an optical component, the optical component comprising a substrate having an optical surface, and a mounting frame for mounting the substrate. The method comprises assembling the optical component by mounting the substrate on the mounting frame, measuring a shape of the optical surface of the substrate, and processing the optical surface of the substrate, wherein the substrate is

mounted on the mounting frame during the measuring of the shape of the optical surface and the processing of the optical surface.

The Office alleges that feature 25 of Oshino corresponds to the claimed mounting frame, but this characterization is erroneous. Feature 25 of Oshino is described therein as a “holding device 25” that comprises “multiple ‘anchoring members’ 22 placed at respective locations around the perimeter of the optical element 20” wherein the optical element 20 has “respective mounting ears 24 . . . extending outward from the side surface of the optical element.” *See* Oshino at ¶ [0036-37] and Fig. 2a. Oshino also describes similar anchoring members 42 in connection with Fig. 5 therein and *explicitly distinguishes the anchoring members from holding frames*. For example, Oshino recites that:

Releasable attachment of the anchoring members to the holding frame can be accomplished by providing each anchoring member with a releasable attachment mechanism, or by providing the holding frame with a respective releasable attachment mechanism for each anchoring member, or both.
Col. 14, lines 19-24.

Moreover, Oshino explicitly states that the *holding frames are different for different measuring and processing tasks*. For example, Oshino states:

[V]arious mirror-related tasks are required, such as mirror-shape measurements, mirror-polishing, wave-front measurements, etc. *Each of these tasks typically requires that the mirror be held by a different holding frame.* Col. 13, lines 49-56 (emphasis added)

A representative “out of column” procedure is polishing The anchoring members (while remaining attached to the optical element) can be *mounted in another holding frame for polishing*. Col. 15, lines 10-20 (emphasis added)

Therefore it must be true that the anchoring members disclosed in Oshino are not properly a mounting frame, but rather are members that anchor an optical element to a frame – and thus the anchoring members and the frame are different. Attachment members are likewise different from a mounting frame as recited in Applicant’s disclosure. For example, exemplary attachment members (*e.g.* lugs 41, lugs 141, and contact portions 241) disclosed in Applicant’s disclosure serve to mount an optical element to a mounting frame. Thus, contrary to the Office’s assertion, Oshino’s anchoring members that constitute the holding device 25 do not properly correspond to the claimed mounting frame. Claim 9 is not anticipated by Oshino for at least this reason.

Independent claim 20 is distinguishable over Oshino at least for reasons similar to those set forth above since similar distinctions apply.

Independent claim 23 is distinguishable over Oshino at least for reasons similar to those set forth above since similar distinctions apply. Moreover, claim 23 is distinguishable because it also recites mounting the substrate on the mounting frame via plural attachment members, the attachment members being attachable to the substrate, measuring a shape of the optical surface of the substrate while the substrate is mounted on the mounting frame, and processing the optical surface of the substrate while the substrate is mounted on the mounting frame. To the extent Oshino's anchoring members might hypothetically correspond to the claimed attachment members, Oshino does not disclose a common holding frame that is attached to an optical element during both measuring and processing.

Independent claim 34 is distinguishable over Oshino at least for reasons similar to those set forth above since similar distinctions apply.

Thus, independent claims 9, 20, 23, and 34 are not anticipated by Oshino for at least these reasons and withdrawal of the rejection is respectfully requested. Claims 10-15, and 26-29 are allowable at least by virtue of dependency from claim 9. Moreover, the Office's rejection of claim 14 does not even allege that Oshino discloses the entire subject matter of claim 15, and the rejection is plainly deficient for this additional reason.

Furthermore, the Office is factually incorrect in rejecting claims 28, 29, 32, 33, 38 and 39. The Office alleges that Fig. 2(a) of Oshino shows a mounting frame as a ring-shaped member. Even assuming *arguendo* that the anchoring members did correspond to a mounting frame, taken together Fig. 2(a) and 2(b) clearly show that the anchoring members are in no way ring-shaped as recited in claims 28, 32, and 38. Similarly, it is clear that the three discrete anchoring members of Fig. 2(a) and 2(b) are in no way "*a continuous member*" that provides support for the substrate at multiple locations" as recited in claim 29, 33, and 39. Thus claims 28, 29, 32, 33, 38 and 39 are not anticipated by Oshino and the rejection of these claims is clearly deficient for these additional reasons.

II. Le Saux fails to disclose all the elements of claims 9, 10, and 13.

The Office Action includes a rejection of claims 9, 10 and 13 (as best understood) under 35 U.S.C. § 102(b) as allegedly anticipated by Le Saux. The Office alleges that the processing disclosed in step 57 (Fig. 7) of Le Saux satisfies the claimed processing recited in claim 9 of Applicant's disclosure. This allegation is erroneous. As indicated at Le Saux Col. 10, lines 7-11, the processing described in Le Saux is a *processing of measurements* of an

optical surface done by a “computer means” and has nothing whatsoever to do with any type of *processing of an optical element* as recited in claim 9. The specification of Applicant’s disclosure describes an example of processing as follows: “[T]he optical surface of the substrate is *processed by computer-controlled polishing of IBF in order to change a shape of the optical surface* to be closer to a target shape . . .” Paragraph [0065]. Plainly the processing disclosed in Le Saux does not correspond to the processing recited in claim 9. Thus claims 9, 10, 13, 20, and 23 are patentable over Le Saux for at least this reason and withdrawal of the rejection is requested.

III. Oshino or Le Saux in view of Malyak fail to disclose all the elements of claim 16.

The Office Action includes a rejection of claim 16 under 35 U.S.C. 103(a) as allegedly obvious over either Oshino or Le Saux in view of Malyak. This rejection is traversed insofar as the Office’s reliance on Malyak does not make up for the deficiencies of Oshino or Le Saux described above. Withdrawal of the rejection is requested.

IV. Claims 27, 31, and 37 should be considered and are not in an improper dependent form.

The Office Action states that claims 27, 31, and 37 appear to belong to the non-elected Species F, and thus they should be withdrawn from consideration as being directed to a non-elected invention. This is improper because the Office has failed to identify mutually exclusive characteristics of the alleged species as required by MPEP § 806.04(f). Section 806.04(f) states that to require restriction between claims limited to species, the claims must not overlap in scope. Claim 27, for example, recites in pertinent portions “mounting another substrate on the mounting frame”, which the Office asserts should be classified as Species F. However, this limitation is in no way mutually exclusive with the limitations of claims 9-16, which recite methods of manufacturing an optical component, the optical component comprising a substrate having an optical surface, and a mounting frame for mounting the substrate. Thus claim 27 has been improperly withdrawn from consideration and the restriction should be withdrawn. Claims 31 and 37 have similar recitations and the restrictions should be withdrawn at least for reasons similar to those set forth above.

The Office objected to claims 27, 31, and 37 as allegedly in improper dependent form because there “is no process of mounting another substrate on the mounting frame in claims 9 and 23” (Office Action dated 8/17/07 at 2) from which claims 27, 31, and 37 depend. This is improper. Claim 27 recites in pertinent portions: “The method of claim 9, comprising mounting another substrate on the mounting frame.” Thus claim 27 includes the limitation of

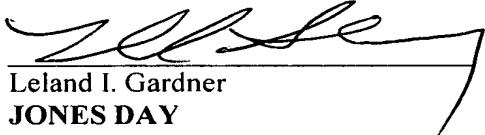
“mounting another substrate” in addition to the existing limitations of claim 9. While true that claim 9 does not already contain the new limitation recited in dependent claim 27, this fact does not create proper grounds for an objection under 37 C.F.R. 1.75(c). Dependent claims by definition add limitations that are not present in independent claims. Similar reasoning applies to claims 31 and 37. Accordingly, the objection to claims 27, 31, and 37 should be withdrawn. Additionally, claims 27, 31, and 37 are patentable at least by virtue of their dependency from claims 9, 23, and 34. Moreover, none of the cited references disclose “mounting another substrate on the mounting frame” as recited in claims 27, 31, and 37, and thus these claims are patentable for this additional reason.

CONCLUSION

For at least these reasons, it is respectfully requested that the rejections of claims 9-16, 20, 23, 26, 28-30, 32-36, 38, and 39, be withdrawn, claims 27, 31, and 37 should be considered and the objections withdrawn, and that a Notice of Allowance be issued.

Respectfully submitted,

Date: January 16, 2008


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